APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,537	01/23/2004	Atsushi Tomita	009683-496	2578

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	EXAMINER
	KOSTAK, VICTOR R

ART UNIT	PAPER NUMBER
2622	

DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/762,537	TOMITA ET AL.
	Examiner	Art Unit	
	Victor R. Kostak	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-17</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) <u>1-17</u> is/are rejected.
7) ☒ Claim(s) <u>11 and 13</u> is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on <u>23 January 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☒ All   b)☐ Some * c)☐ None of:
      1.☒ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>01/23/04</u>.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1.   The lengthy specification has not been checked to the extent necessary to determine the

presence of all possible minor errors. Applicant's cooperation is requested in correcting any

errors of which applicant may become aware in the specification.

2.   Claims 11 and 13 are objected to because of the following informalities: in the

penultimate line of claim 11 and in line 4 of claim 13, "*video*" is misspelled.

Also in claim 13, in line 3, "*pint*" should be changed to – print --.

Appropriate correction is required.

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-7 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by

Walkingshaw et al.

The broadcast receiver of Walkingshaw (noting Figs. 1A and 2) includes an image

forming apparatus (the television display, not shown, or printer 140), wherein the subscriber's

unit 100 (corresponding to the claimed reception section) receives broadcasted signals

comprising print-out data (e.g. coupons) and control data for printing out the coupons (e.g. col. 3

lines 43-52). Microprocessor 110 detects the print-out data and the control data, RAM 122 can

store the coupon, and printer 140 in turn prints out the coupon based on the received control data,

thereby meeting claim 1.

As for claim 14, the computer program product is the software in ROM 120 that microprocessor 110 operates on to carry out the printing operation.

As for claim 5, the subscriber's unit 100 is the claimed reception section, which comprises detection section 110. The first and second notification sections also read on the microcomputer, which microcomputer notifies the image forming apparatus (printer 140) of both the print-out data and the control data used to carry out the printing. RAM 122 stores the print-out data under the control of the first notification section (microprocessor 110), and the output section (printer 140) then prints out the data based on the second notification data (i.e. the control data processed by the microcomputer).

As for claims 2 and 6, the printer is activated (i.e. removed from an idle state) upon receiving the printer and control data (e.g. col. 4 lines 1-3; col. 5 lines 8-11), meaning that when the printer/receiver is prompted by the control signal (i.e. first signal), then it operates also as what can be designated as a second control signal, which first removes the printer from the idle state, and then commences printing.

Regarding claims 3 and 7, the transition section is the microprocessor acting as a controller of printer 140 to transition it from the idle state to the active state.

4.   Claims 1, 4, 5, 9, 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson et al.

Johnson also incorporates a printer with his television receiver (noting particularly Figs. 1-3), wherein receiver/decoder (noting Figs. 2 and 3) includes an image forming apparatus (the television display, not shown, or printer 50), wherein the cable subscriber's unit (corresponding

to the claimed reception section) receives broadcasted signals comprising print-out data (element 52) and control data for printing out the data (e.g. col. 5 lines 40-63). Microprocessor 60 detects the print-out data and the control data, RAM 48 can store the print-out data, and printer 50 in turn prints out the coupon based on the received control data, thereby meeting claim 1.

As for claim 14, Johnson uses a PROM 46 in cooperation with the microprocessor for executing the system instructions.

Considering claim 5, receiver/printer station (Fig. 2) is the claimed reception section, which comprises detection section 44. The first and second notification sections also read on the microcomputer 60, which microcomputer notifies the image forming apparatus (printer 50) of both the print-out data and the control data used to carry out the printing. RAM 48 stores the print-out data under the control of the first notification section (microprocessor 60), and the output section (printer 50) then prints out the data based on the second notification data (i.e. the control data processed by the microcomputer).

As for claims 4, 9 and 15, the microcomputer also detects the end of signal transmission, and the data is erased from RAM 48 (col. 5 lines 48-56 and col. 10 lines 55-60).

5.   Claims 11-14 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Bullock et al.

Noting Figs. 1 and 4 of Bullock, he transmits print-out data (e.g. coupons, advertisements: col. 2 lines 50-57) with video broadcast data (col. 2 lines 44-50), as a first step. As a second step, a cue signal is transmitted therewith (e.g. col. 59-62) for controlling a printer

58 at the receiver 40 to print out the data at a predetermined time relative to the broadcast data

(e.g. col. 6 lines 34-37), thereby meeting claim 12.

As for claim 13, the video information is a sequence of frames (characterizing a video

broadcast), and the control section (governed by microprocessor 50) includes data to (at least)

prohibit printing (col. 8 lines 6-20).

As for claims 11 and 14, the microprocessor 50 includes a ROM/RAM 52 that allows for

the acquiring of program data to identify and separate broadcast data from auxiliary (print-out)

data, which separation is controlled by the microprocessor. The microprocessor sends out both

the data to be printed out and commands the RAM to print out the data on printer 58.

Regarding claim 17, the control data can be sent out from a different broadcast than the

programming (A/V) signal (col. 3 lines 10-18).

6.   Claims 5 and 14 are also rejected under 35 U.S.C. 102(b) as being anticipated by

Summers.

Summers also incorporates a printer 28 with his television receiver (noting particularly

Fig. 2), wherein receiver 14 includes an image forming apparatus (read out 30 or printer 28),

wherein the subscriber's unit (corresponding to the claimed reception section) receives

broadcasted signals comprising print-out data and control data for printing out the data (e.g. col.

4 lines 56-64). Device 16 detects the print-out data and the control data, store 36 can store the

print-out data, and printer 28 in turn prints out the data based on the received control data.

Receiver/printer station (Fig. 2) is the claimed reception section, which comprises detection

section 16. The first and second notification sections read on the acceptor 20, which notifies the

image forming apparatus (printer 28/30) of both the print-out data and the control data used to

carry out the printing. Device 36 stores the print-out data under the control of the first

notification section, and the output section (printer 50) then prints out the data based on the

second notification data (i.e. the control data processed by the microcomputer).

As for claim 14, Summers uses a controller 22 and points out that a computer can be used

at the receiver (col. 7 lines56-61), which typically incorporates programming data to execute the

instructions contained therein, in turn, carrying out the printing/storing processes.

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Summers.

Summers points out that the broadcast and desired print-out data can be transmitted at

different predetermined times (col. 7 lines 63-68). It would therefore have been obvious to one

of ordinary skill in the art to ensure that a determination is made by the receiver of the timing

relationship of when to receive/display the programming and when to print out the data relative

to the programming, so determined by each individual user.

8.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Victor R. Kostak whose telephone number is (571) 272-7348.

The examiner can normally be reached on Monday - Friday from 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David W. Ometz can be reached on (571) 272-7593. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, Virginia 22313-1450

Or faxed to:

(571) 273-8300

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service Office whose telephone number is (703) 308-HELP.

Victor R. Kostak
Primary Examiner
Art Unit 2622

VRK